The following anticipation rejections under 35 USC §102 are set forth in the outstanding Office Action:

(1) claims 21 - 30 stand rejected under 35 USC §102(e) as being anticipated by Tabersky (U.S. Patent No. 5,981,078);

(2) claims 19, 21 and 22 - 30 stand rejected under 35 USC §102(e) as being anticipated by Kukino (U.S. Patent No. 5,700,551);

(3) claims 21 - 30 stand rejected under 35 USC §102(b) based on Japanese Patent Publication No. 6-17228;

(4) claims 20 - 30 stand rejected under 35 USC §102(b) as being anticipated by German Patent Publication No. 43 17 758; and

(5) claims 19 and 22 - 30 stand rejected under 35 USC §102(b) as being anticipated by JapanesePatent Publication No. 55 120936 or "Nissin Electric (Abstract of JP 05250770)."

The applicants respectfully submit that no new matter has been added.

In each of the above-cited anticipation rejections, the Examiner has taken the position that: "the [applicants' claimed] lattice constant is considered inherent."[1]

[1] Please see, line 4 in each of items 2 - 6, pages 2 and 3 of the outstanding Action.

At the outset, with respect to the Examiner's position on *inherency,* MPEP Sec. 2112 states, in part, that:

> [t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).
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> * * *
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> In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art." Emphasis in part, emphasis added in part. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

As set forth in each of independent claims 19 and 21, the claimed sliding member includes the claimed nitride base material "having a face-centered cubic crystalline structure with a lattice constant ranging from 0.414 to 0.423 nm in a crystal of said nitride-based material." Such structural feature of the applicants' claimed nitride-based material is produced in the manner, as discussed in, e.g., line 2, page 12 through line 5, page 13 of the applicants' specification.

As to the cited prior art references, first, in Tabersky, the process for "tests 1 to 5" is described starting from line 61, column 5 through line 9, column 6, while the process for "tests 6 to 11" is described starting from line 58, column 7 though line 17, column 8 in Tabersky.

However, the above-discussed process of the applicants' invention is distinguishable over Tabersky's processes. Thus, there is no basis in fact and/or technical reason to reasonably support the Examiner's position that the applicants' lattice constant is "considered inherent"in Tabersky's composite body.

Secondly, the above-described process for producing the applicants' claimed hard coating is distinguishable over Kukino's deposition methods, including known CVD technique in which a combination of TiN and $Al_2O_3$ was deposited as a hard coat layer, sputtering technique or the like, as described in the Kukino patent.

Thus, as in Tabersky, there is no basis in fact and/or technical reason to reasonably support the Examiner's position that the applicants' lattice constant is "considered inherent" in Kukino's hard composite material.

Thirdly, it is clear that the limited Abstract provided by the Examiner with respect to the JP '228 document is not at all concerned with a deposition method for making hard coatings, as described above with respect to the applicants' invention. (Again, see, e.g., line 2, page 12 through line 5, page 13 of the applicants' specification.)

Fourth, as to the German Patent Publication, the copy provided by the Examiner also includes a limited Abstract, which clearly does not disclose the above-discussed deposition methodology for making hard coatings, as discussed in, e.g., line 2, page 12 through line 5, page 13 of the applicants' specification.

In view of the above, it is the applicants' position that the Examiner has failed to provide the basis in fact and/or technical reasons to reasonably support his alleged determination that the applicants' lattice constant is considered inherent in the composites produced in JP '228 and the German Patent Publication.

In addition, independent claim 20 is rejected in item 1, page 2 of the outstanding Action only for the reason that, according to the Examiner, "the lattice constant is considered inherent." However, claim 20 does not claim such lattice constant.

Fifth, the disclosure found in the limited Abstract of JP '936 also fails to disclose the above-discussed applicants' deposition process for achieving the claimed hard coating having the nitride-based material; as such, the Examiner's allegation that the applicants' claimed lattice constant being considered inherent should similarly fail. This same rational is applicable in arguing against the teachings found in the Abstract of JP '770, a copy of which was filed in the Information Disclosure Statement dated April 23, 2001.

In view of the above, the applicants respectfully submit that there is no requisite basis in fact and/or technical reasoning to reasonably support the Examiner's determination that the applicants' claimed lattice constant, as set forth in each of independent claims 19 and 21, is considered inherent. As to the Examiner's reliance on the German Patent Publication in rejecting independent claim 20, claim 20 does not call for the claimed lattice constant range.

Accordingly, it is respectfully submitted that not all of the claimed elements or features, as set forth in claims, are found in exactly the same situation and united in the same way to perform the identical function in any one of the cited references. Thus, there can be no anticipation of the applicants' claimed invention under 35 USC §102 based on the cited prior art.

Thus, the withdrawal of the outstanding anticipation rejections under 35 USC §102 is in order, and is therefore respectfully solicited.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees which may be due with respect to this paper may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

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